

Attorney Docket No.: IMMR-IMD0002C (434701-067)

**REMARKS**

The Final Office Action mailed on November 28, 2008 has been carefully considered. In the Office Action, Claims 12-18 stand rejected and Claims 19-24, 26-28, 30, 31 and 33 are allowed. The Applicants respectfully request reconsideration of the present application in light of the amendments above and the remarks below. Applicants hereby reply within the two month date of the Final Office Action.

**Allowed Claims**

In the Office Action, Claims 19-24, 26-28, 30, 31 and 33 are allowed.

**Rejection Under 35 U.S.C. § 103**

Claims 12-18 stand rejected as being allegedly unpatentable over Bailey (US Patent No. 5,800,179) in view of Humes et al. (US Patent No. 1,889,330). The Applicants respectfully traverse.

Within the office action, it is stated that Bailey discloses a capture mechanism configured to engage a peripheral device, and a sensing assembly to detect movement of the peripheral device while engaged. The office action admits that Bailey fails to disclose any details of a clamping apparatus. The office action states that Humes discloses a device for a screwdriver which automatically grasps and retains the screw with a plurality of jaws, whereby the jaws are actuated by a lever device which is actuated in response to relative movement of the device as the screw is being inserted. It is stated in the office action that it would have been obvious to one skilled in the art to utilize the clamping mechanism in Humes with the system in Bailey to reach the claimed subject matter. The Applicants respectfully disagree.

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In determining obviousness four factual inquiries must be looked into in regards to determining obviousness. These are determining the scope and content of the prior art; ascertaining the differences between the prior art and the claims in issue; resolving the level of ordinary skill in the pertinent art; and evaluating evidence of secondary consideration. Graham v. John Deere, 383 U.S. 1 (1966); KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007) ("Often, it will be necessary . . . to look into related teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit.**") (emphasis added).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

One skilled in the art would have no motivation to combine Bailey and Humes in reaching the claimed subject matter. Humes is directed to a screw holding attachment for screw drivers, whereas Bailey is directed to medical training device in which surgical implement is inserted into a housing. In particular, Hume's device has a screw holding sleeve 14 attached to

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the screw driver shank 14 in which the sleeve 14 has a slit 15 that is expandable to allow a screw to be inserted from the side. (Humes, Col 2, Lines 61-64). A clamping sleeve 22 is moved along the shank 14 to close the ends of the sleeve 22 around the screw to hold the screw in place. The screw driver is then able to longitudinally traverse down the sleeve 14 to engage the held screw.

Although the office action states that Hume's clamping apparatus can be used with the system in Bailey, Applicants contend that there is no requisite motivation to combine Bailey with Humes. First, Bailey's surgical implement 2 is described to be already inserted into the housing 1 through an aperture 9. Additionally, there is no hint, teaching or suggestion in Bailey that the surgical implement is removeable from within the housing 1. Accordingly, there would no motivation for one skilled in the art, reading Bailey, to desire a capture mechanism of any sort, because the surgical implement is already attached to the internal sensing mechanism inside housing 2.

In contrast, Hume's device requires an external element (i.e. a screw) to be inserted through a side of the sleeve, whereby the sleeve is then moved to hold the screw in place. There is no desire nor motivation in either reference as to why or how the device in Humes could be combined with the sophisticated pulley and frame assembly in Bailey to engage the surgical implement. For one skilled in the art to implement the device in Humes with the complex, existing framed assembly 46 in Bailey's housing 1 would require substantial redesign of Bailey's system to allow the framed assembly 46, guide rails 11 and pulley system 22 to operate with Hume's sleeve and screw holding configuration. Therefore, the combination of Bailey and Humes would require a substantial reconstruction and redesign of the elements shown in Bailey as well as a change in the basic principle under which the Bailey construction was designed to operate. In re Ratti, 270 F.2d 810 (CCPA 1959); see MPEP 2143(VI). For at least these reasons,

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one skilled in the art would have no motivation to combine Bailey and Humes to reach the claimed subject matter in Claim 12.

Furthermore, the combination of Bailey and Humes does not teach or suggest each and every element/limitation in Claim 12 as required to establish a *prima facie* case of obviousness. Claim 12 recites, *inter alia*, the dimension-adjusting mechanism configured to cause the adjustment of the coupling mechanism in response to the peripheral device pushing against the dimension-adjusting mechanism in a direction substantially parallel to the direction of movement of the peripheral device when the peripheral device is engaged by the capture mechanism. Instead, Humes describes that the screw pushes against the sleeve in a direction perpendicular to the movement of the sleeve (i.e. causing the ends of the sleeve to urge outward), whereby the sleeve 22 is pushed down longitudinally over the ends of sleeve 14 to engage the screw. This is different than the language in Claim 12. Accordingly, the combination does not teach or suggest each and every element/limitation in Claim 12. For at least these reasons, Claim 12 is allowable over Bailey and Humes.

Claims 13-18 are dependent on independent Claim 12. As stated above, Claim 12 is in a condition for allowance. Accordingly, Claims 13-18 are allowable for being dependent on an allowable base claim.

#### Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

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If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-3557.

Respectfully submitted,

Dated: January 28, 2009

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